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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/710,332

07/01/2004

David S. Bonalle

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07/19/2005

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EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/710,332

Applicant(s)

BONALLE ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7-04 and 8-04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACITON

1. Receipt is acknowledged of the IDS received on 1 July 2004 and 1 August 2004.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6, and 8-12 of copending Application No. 10708838 (US 2004/0233039) and claims 1-12 of copending Application No. 10708839 (US 2004/0232224). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is a broader recitation of the '838 Application.

For instance in claims 1, 2, and 6 of the present claimed invention and claims 1 and 7 of the '838 Patent Application, the Applicants claim:

i) "...contacting an authorized sample receiver...proffering a biometric...obtains a biometric....providing user information and smartcard information...to

facilitate....associating said biometric sample with user information and transponder information to create a data packet.” (see claim 1), whereas in the ‘838 Patent Applicant the Applicants claim “...a biometric sensor... a device configured to associate said proffered biometric... with user information and transponder information to create a data package...” (see claim 1). Though silent to an authorized sample receiver, it is obvious to contact an authorized receiver in order to successfully complete the steps, for contacting an unauthorized receiver would be counterproductive.

Re claim 2 of the present claimed invention, it is obvious that an authorized receiver would include at least one of computer, internet, software, hardware, third party biometric entity, kiosk, biometric registration terminal, and communication device, as such devices are well known and conventional for receiving samples for storing/processing, and therefore is an obvious expedient. Additionally, claim 6 and 7 of the ‘838 Patent Application claims “...the database is contained in at least one of the transponder, transponder reader...” (see claim 6) and “...the remote database is configured to be operated by an authorized sample receiver...” (see claim 7). Accordingly, it would have been obvious that such a receiver would include one of the claimed types of receivers, for receiving biometric data in a well know and conventional means, to facilitate storing and processing.

Re claim 6 of the present claimed invention, as discussed above, claim 1 of the ‘838 Patent Application teaches registering, and therefore it is obvious that such associating facilitates registration.

For instance in claim 3 of the present claimed invention and claim 2 of the '838 Patent Application, the Applicants claim:

ii) "...facilitates at least one of processing, storing, comparing, and verifying said biometric sample" (see claim 3), whereas in the '838 Patent Application the Applicants claim "...process store, and verify said proffered biometric sample" (see claim 2).

For instance in claim 4 of the present claimed invention and claim 3 of the '838 Patent Application, the Applicants claim:

iii) "...facilitates associating said proffered biometric sample with at least one of personal information, credit card information, debit card information, savings account information, and loyalty point information" (see claim 4), whereas in the '838 Patent Application the Applicants claim "...facilitate association of said proffered biometric sample with at least one of personal information, credit card information..." (see claim 3).

For instance in claims 5 of the present claimed invention and claim 6 of the '838 Patent Application, the Applicants claim:

iv) "...storing said data packet on a database, wherein said database is contained in at least one of a transponder, transponder reader..." (see claim 5), whereas in the '838 Patent Applicant the Applicants claim "...wherein said database is contained in at least one of the transponder..." (see claim 6).

For instance in claim 7 of the present claimed invention and claim 4 of the '838 Patent Application, the Applicants claim:

v) "...associating different proffered biometric samples with a different one of ... " (see claim 7), whereas in the '838 Patent Application the Applicants claim "...different proffered biometric samples are associated with a different one of..." (see claim 4).

For instance in claim 8 of the present claimed invention and claim 8 of the '838 Patent Application, the Applicants claim:

vi) "...primarily associating....secondarily associating...second user information is different than said first user information" (see claim 8), whereas in the '838 Patent Application the Applicants claim "...primarily associate...secondarily associate....said second user information is different than said first user information" (see claim 8).

For instance in claim 9 of the present claimed invention and claim 9 of the '838 Patent Application, the Applicants claim:

vii) "...first proffered biometric sample with at least one of first user information....second proffered biometric sample....second user information..." (see claim 9), whereas in the '838 Patent Application the Applicants claim "...first proffered biometric sample...first user information....second proffered biometric sample...second user information..." (see claim 9).

For instance in claim 10 of the present claimed invention and claim 10 of the '838 Patent Application, the Applicants claim:

viii) "...first proffered biometric sample with at least one of first user information....second proffered biometric sample....second user information...second user information is different than said first user information" (see claim 10), whereas in the '838 Patent Application the Applicants claim "...first proffered biometric sample...first user information....second proffered biometric sample...second user information... second user information is different than said first user information" (see claim 10).

For instance in claim 11 of the present claimed invention and claim 11 of the '838 Patent Application, the Applicants claim:

ix) "...wherein each proffered biometric sample is associated with a different user information" (see claim 11), whereas in the '838 Patent Application the Applicants claim "...wherein each proffered biometric sample is associated with different user information" (see claim 11).

For instance in claim 12 of the present claimed invention and claim 12 of the '838 Patent Application, the Applicants claim:

x) "...facilitating the use of one or more secondary security procedures" (see claim 12), whereas in the '838 Patent Application the Applicants claim "...one or more secondary security procedures..." (see claim 12).

For instance in claims 1 of the present claimed invention and claim 1 of the '839 Patent Application, the Applicants claim:

i) "...registering biometric...smartcard system...smartcard information to create a data packet." (see claim 1), whereas in the '839 Patent Applicant the Applicants claim "...registering a biometric...transponder-reader system...transponder information to create a data packet." (see claim 1).

For instance in claim 2 of the present claimed invention and claim 2 of the '839 Patent Application, the Applicants claim:

ii) "...contacting...kiosk..communication device" (see claim 2), whereas in the '839 Patent Applicant the Applicants claim "...contacting...kiosk..communication device" (see claim 2).

For instance in claim 3 of the present claimed invention and claim 3 of the '839 Patent Application, the Applicants claim:

iii) "...smartcard information...facilitates at least one of...verifying said biometric sample." (see claim 3), whereas in the '839 Patent Applicant the Applicants claim "...transponder information...facilitates at least one of...verifying said biometric sample." (see claim 3).

For instance in claim 4 of the present claimed invention and claim 4 of the '839 Patent Application, the Applicants claim:

iv) "...user information and smartcard information...loyalty point information." (see claim 4), whereas in the '839 Patent Applicant the Applicants claim "...user information and transponder information...loyalty point information." (see claim 4).



For instance in claim 5 of the present claimed invention and claim 5 of the '839 Patent Application, the Applicants claim:

v) "...user information and smartcard information...merchant server and smartcard reader." (see claim 5), whereas in the '839 Patent Applicant the Applicants claim "...user information and transponder information...merchant server and transponder-reader system." (see claim 5).

For instance in claim 6 of the present claimed invention and claim 6 of the '839 Patent Application, the Applicants claim:

vi) "...user information and smartcard information...registration of a biometric sample." (see claim 6), whereas in the '839 Patent Applicant the Applicants claim "...user information and transponder information...registration of a biometric sample." (see claim 6).

For instance in claim 7 of the present claimed invention and claim 7 of the '839 Patent Application, the Applicants claim:

vii) "...user information and smartcard information...different proffered biometric sample...loyalty point information." (see claim 7), whereas in the '839 Patent Applicant the Applicants claim "...user information and transponder information...different proffered biometric sample...loyalty point information." (see claim 7).

For instance in claim 8 of the present claimed invention and claim 8 of the '839 Patent Application, the Applicants claim:

viii) "...user information and smartcard information...second user information is different than said first user information." (see claim 8), whereas in the '839 Patent

Applicant the Applicants claim "...user information and transponder information...second user information is different than said first user information." (see claim 8).

For instance in claim 9 of the present claimed invention and claim 9 of the '839 Patent Application, the Applicants claim:

ix) "...user information and smartcard information...second proffered biometric sample...loyalty point information." (see claim 9), whereas in the '839 Patent Applicant the Applicants claim "...user information and transponder information...second proffered biometric sample...loyalty point information." (see claim 9).

For instance in claim 10 of the present claimed invention and claim 10 of the '839 Patent Application, the Applicants claim:

x) "...user information and smartcard information...second user information is different than said first user information." (see claim 10), whereas in the '839 Patent Applicant the Applicants claim "...user information and smartcard information...second user information is different than said first user information." (see claim 10).

For instance in claim 11 of the present claimed invention and claim 11 of the '839 Patent Application, the Applicants claim:

xi) "...user information and smartcard information...sample is associated with different user information." (see claim 11), whereas in the '839 Patent Applicant the Applicants claim "...user information and transponder information...sample is associated with different user information." (see claim 11).

For instance in claim 12 of the present claimed invention and claim 12 of the '839 Patent Application, the Applicants claim:

xii) "...providing user information...secondary security procedures." (see claim 12), whereas in the '839 Patent Applicant the Applicants claim "...providing user information...secondary security procedures." (see claim 12).

The Examiner notes that though claims 1-12 of the current pending application are drawn to a smartcard, and that claims 1-12 are drawn towards a "transponder reader" the Examiner notes that such modification is well within the ordinary skill in the art, motivated by a particular type of well-known communications protocol/means, based on system constraints/design, or for adjusted range of communications. Both smart cards and transponders are well known and conventional means of wirelessly communication information in a small form package (card, for example), and modification of the smartcard claims of the prior art are therefore obvious and conventional, and are an obvious expedient. Additionally, the Examiner notes that such cards that communicate via RF are also well known and conventional, and can be interpreted as transponders (see Black (US 2005/0122209), below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black (US 2005/0122209).

Re claim 1, Black teaches contacting an authorized sample receiver (FIG. 1A, FIG. 5A, abstract); proffering a biometric to a biometric sensor such that the sensor obtains a biometric sample (FIG. 1A, FIG. 5A, abstract); user information and smartcard information to the system to facilitate the system associating the biometric sample with user information and smartcard information to create a data packet (FIG. 10A-11, 14a). The user information stored is interpreted as a data packet that associates user information, biometric information, and smartcard information. The Examiner notes that though Black is silent to the information being provided (such as smartcard information), it is obvious to the Examiner to provide such information as part of the registering process.

Re claim 2, Black teaches contacting an authorized sample receiver through at least one of a computer Internet, software, hardware, third party biometric entity, kiosk, biometric registration terminal, and communication device (FIG. 5A).

Re claim 3, Black teaches the step of providing user information and smartcard information to the system to facilitate the system associating the biometric sample further facilitates at least one of processing, storing, comparing, and verifying the biometric sample, as a record is created (FIG. 14A).

Re claim 4, it has been discussed above that the proffered biometric sample is associated with at least one of personal information, credit card information, debit card information, savings account information, and loyalty point information (FIG. 10A-11B, FIG. 14A).

Re claim 5, Black teaches (FIG. 1A) that the data can be stored on a host computer or on the smartcard itself (paragraph [0090]), where is interpreted as being contained in at least one of a transponder, smartcard reader, sensor remote server, merchant server, and transponder-reader system. Though Black is silent to database, Black teaches that according to the desired security, information can be stored on the smartcard itself or remotely. Therefore, it is well within the skill in the art to store the data packet information at one of the locations set forth in the claim, depending on the desired type of security.

Re claim 6, Black teaches that the user record (FIG. 10A-11B, 14A) includes a biometric sample, user information and smartcard information. Though silent that the providing of user and smartcard information facilitates registration of a biometric sample, it is obvious that providing the smartcard information, user information and biometric information facilitates registration of the sample, for establishing an account for subsequent transactions. Such provision of information is an obvious expedient for a registration process.

4. Claim 7 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as discussed above, in view of Maritzen et al. (US 2002/0191816).

Re claim 7, the teachings of Black have been discussed above.

Black is silent to associating different proffered biometric samples with a different one of personal information, credit card information, debit card information, savings account information, and loyalty point information.

Maritzen et al. teaches that different biometric samples can be associated with a different one of personal information, credit card information, debit card information, savings account information, and loyalty point information (paragraph [0074]).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Black with those of Maritzen et al.

One would have been motivated to do this to associate different biometric samples with different accounts for ensuring unique security for different accounts.

Re claim 9, the teachings of Black have been discussed above.

Black is silent to associating a first biometric sample with one of a first user information and associating a second biometric sample with at least one of second user information.

Martizen et al. teaches such limitations (paragraph [0074]).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Black with those of Martizen et al.

One would have been motivated to do this to provide security for accounts via unique biometric samples.

Re claim 10, the limitations have been discussed above re claim 9.

Re claim 11, the limitations have been discussed above re claim 10.

Re claim 12, the Examiner notes that Black is interpreted to teach verifying the biometric sample by facilitating the use of one or more secondary security procedures is taught via the electronic and digital signatures being captured (FIG. 14A) which provides secondary security for verification for a transaction. The Examiner also notes that PINs are well-known and conventional secondary procedures, known in the art (US 2005/0054438, US 2004/0199469, etc.)

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as discussed above, in view of Moebs et al. (US 2005/0065872).

The teachings of Black have been discussed above. Re claim 8, FIG. 10A-11B teaches the biometric sample is primarily associated with at least one of first user information (account number).

Black is silent to the biometric sample being secondarily associated with a second user information, different from the first.

Moebs et al. teaches that a customer can avoid overdrafts by preauthorizing the financial institution to tie the customer's checking account to one or more of the customer's other accounts such as deposit accounts (paragraph [0017]). The Examiner notes that overdraft protection is well known and conventional in the art. Accordingly, the Examiner notes it would have been obvious that by linking an overdraft account to a primary account that is associated with the sample, that the overdraft account is interpreted as being secondarily associated with the sample, for if the primary account is overdrawn, the secondary account is drawn upon.

One would have been motivated to combine the teachings of Black with those of Moebs, in order to provide overdraft protection for the convenience of the user.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Martizen et al., in view of Iannacci (US 2002/0062249).

The teachings of Black have been discussed above.

Black is silent to multiple accounts and multiple biometric identifiers.

The teachings of Martizen et al. regarding such limitations has been discussed above (see claim 4, for example) where Martizen et al. teaches different biometric identifiers associated with different accounts.

Black/Martizen et al. are silent to primarily associating a biometric sample with first user information and secondarily associating it with a second user information (different from the first user information).

Iannacci teaches the use of multiple accounts, and that the system automatically selects the best account that would yield the most benefits to the user (paragraph [0122]). Accordingly, in light of the teachings of Black/Martizen et al., Iannacci provides for a means of automatically choosing the best account for a transaction.

One would have been motivated to combine the teachings of Black/Martizen et al. with those of Iannacci.

One would have been motivated to do this to choose the best account for an occasion for user convenience.



### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Meadows et al. (US 5,869,822), Dunn et al. (US 5,987,155), Pare et al. (US 6,269,348), Takhar (US 2001/0053239), Kawan (US 2002/0062284), Doyle et al. (US 2002/0095587), Prokoski et al. (US 2002/0140542), Mirchi et al. (US 2004/0178063), Mitchell et al. (US 2003/0149661), Palmer et al. (US 2003/0226041), Hoffman et al. (US 2004/0020982), Yamagishi (US 2004/0041690), Doughty et al. (US 2004/0133787 and 2005/0001711), Royer et al. (US 2004/0155101), Lee (US 2004/0195314), Barillova et al. (US 2004/0199469), Golden et al. (US 2004/0208343), Beenau et al. (US 2004/0230488, 2004/0232220, 2004/0232224, 2004/0233039, 2004/0236701, 2003/0239480, and 2005/0116024), Haala (US 2005/0005172), Ikeda et al. (US 2005/0018658), Inabe (US 2005/0033992), Rothschild et al. (US 2005/0054438), Kuwana et al. (US 2005/0091325), Haala (US 2005/0102524) and Hoshino et al. (US 6,636,620).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

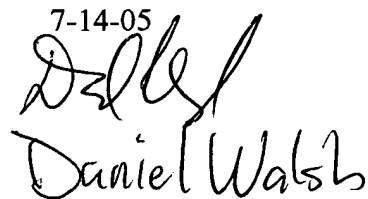
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Daniel I Walsh

Examiner

Art Unit 2876

7-14-05

A handwritten signature in black ink, appearing to read "D. Walsh", is written over the typed name "Daniel I Walsh".